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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,209	09/27/2000	Birgit Boge	HER07 P-106	5284

28101 7590 12/03/2002

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EXAMINER

WACHTEL, ALEXIS A

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/03/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/647,209

Applicant(s)

BOGE ET AL.

Examiner

Alexis Wachtel

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 8-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 8-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Detailed Action***

***Response to Amendment***

1. Applicant's amendment and accompanying Remarks filed 9-25-2002 have been entered and carefully considered.

The amendment is sufficient to overcome the anticipation rejections of claims 1,2 and 8-25 but overcomes the 112 2<sup>nd</sup> paragraph rejections of claims 1,2 and 8-25.

***Claim Rejections - 35 USC § 103***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1,2 and 8-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,866,905 to Bihiy et al as set forth in section 6 and 7 of the last Office Action.

4. Claims 1,2 and 8-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 3713108A as set forth in section 8 and 9 of the last Office Action.

5. Claims 1,2 and 8-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 795424 A1.

Applicant has amended the instant claims to recite features of the graphic design employed. These limitations relating to the specifically claimed graphically marked designs on the surface of the claimed mineral wool sheet are not seen to impart any patentably distinguishing characteristics to the article.

EP 795424 A1 discloses as known, boards made of mineral fibers (English Abstract) which meets the "insulation material sheet" limitations of claims 1 and 2. In

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addition, EP 795424 A1 discloses applying markings to a mineral fiber material for guiding cuts made said mineral fiber material (English Abstract).

EP 795424 A1 as set forth teaches the claimed invention except for the specific graphic design but discloses the same purpose for the markings, i.e. guiding cuts. Since EP 795424 A1 as set forth above teaches to provide graphics on the boards made of mineral fibers, it would have been a matter of obvious design choice to have provided any specific design motivated by the desire to provide user instructions for utilizing the structure or improving product aesthetics.

### ***Response to Arguments***

6. Applicant argues that markings on claimed mineral wool product must be given weight. Examiner wishes to point out that the presence of markings were NOT summarily ignored and dismissed. Applicant misapplies *In re Miller* in that the case is directed to an article having printing on it whereby the Examiner summarily ignored the printed matter limitations. In the instantaneous application, the **specific** (emphasis added) markings Applicant claimed were given no patentable weight since they have not contributed to the structure of the claimed mineral wool product in any novel way over the cited references that incidentally also had markings on them, but the product having markings thereon was given patentable weight.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §

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706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Alex Wachtel, whose number is (703)-306-0320. The Examiner can normally be reached Mondays-Fridays from 10:30am to 6:30pm.

If attempts to reach the Examiner by telephone are unsuccessful and the matter is urgent, the Examiner's supervisor, Mr. Terrel Morris, can be reached at (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
TERREL MORRIS  
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